

Remarks

The December 15, 2008 and February 05, 2009 Actions were reviewed with care in preparation for this amendment and response.

Interview Summary

The undersigned thanks Examiner Parsley for the interview of January 7, 2009, during which the December 15 rejection was discussed. More specifically, the Cooper et al. reference was discussed with respect to a limitation in applicant's independent claim 77 which requires that the light body have a single inner recess and that the LED and the battery both be secured within the single inner recess. The undersigned pointed out that, contrary to the Examiner's assertion in the December 15, 2008 action, the Cooper et al. patent does not show a single inner recess with both the LED and battery secured within such single inner recess as required by applicants' claims. While generally agreeing with this interpretation, the Examiner still proposed further amending independent claim 77 to specifically state that the LED and the battery are both "*entirely disposed* within the single recess" of the light body. The undersigned agrees with the Examiner's suggestion and notes that such minor amendment does not raise any new issues.

In the interview, the undersigned further pointed out that in their earlier responses applicants' have already argued that Blaschke discloses a landing net of such completely different construction that such construction would not allow placement of any kind of illuminator in the same position as in applicants' claimed invention. Therefore, Blaschke should not be used in rejecting applicants' claims.

Based on the points made and after reviewing each of the Figures 8-10 of the Cooper et al. reference, the Examiner stated his conclusion that claim 77, if adjusted as described above, would overcome the rejections based on the Cooper et al. reference in view of various secondary references. Those amendments have now been made.

The Examiner indicated that in considering allowance, he will review more recent prior art to ensure that the invention, as now claimed, has not been disclosed prior to applicants' invention. After the above amendment, claims 77-84 and 92 are pending in the application.

Independent claim 86 has been cancelled without prejudice. Dependent claim 78 has been amended to add further clarity without changing the scope of the claim.

Points of the Office Action

As presented prior to this amendment, claims 77, 80-82, 84 and 86 were rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke and further in view of Baker. Claim 86 has been cancelled without prejudice. Claims 77, 80-82 and 84 are now in condition for allowance, as noted above and further set forth below.

As already stated, independent claim 77 is now amended to emphasize that the LED and the battery are both *entirely disposed* within the single recess. Claim 77 has been further amended to specify that the illuminator is *submersible*.

A new independent claim 92 has been added which includes the above-discussed limitations of claim 77. Claim 92 requires that *all* of the illuminator be disposed in the distal end of the handle, that a *submersible* illuminator include a light body which has a *single* inner recess, and that the LED and the battery both be *entirely disposed* within the single inner recess. New independent claim 92, like amended claim 77, is patentably distinct over the Cooper et al. reference alone or in combination with other secondary references.

Applicants would like to take this opportunity to make the point about the device of the Blaschke patent. The Blaschke net is so different that the suggested modification would simply destroy the principal qualities of such net. When considered in its entirety, the Blaschke patent clearly discloses a structure completely different from applicants' invention.

As already mentioned above, during the interview the Examiner acknowledged that independent claim 77, as amended, is patentably distinct over the Cooper et al. reference combined with the secondary references. Neither Blaschke nor Baker disclose limitations that are lacking from the Cooper et al. reference. Thus, all claims dependent on claim 77, including claims 80-82 and 84, are patentably distinct over the Cooper et al., Blaschke and Backer, alone or in combination.

Dependent claim 78 was rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke and further in view of Baker. This rejection is respectfully traversed in view of the foregoing amendments of the parent independent claim 77 and the above discussion. Claim 78 is in condition for allowance.

Dependent claim 79 was rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke, Baker and further in view of Shiao. This rejection is respectfully traversed in view of the foregoing amendments of the parent independent claim 77 and the above discussion. The Cooper et al., Blaschke, Baker and Shiao patents, even in combination, fail to render obvious applicants' invention as set forth in claim 79. Claim 79 is in condition for allowance.

Dependent claim 83 was rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke, Baker, Shiao and further in view of Brundage et al. This rejection is respectfully traversed in view of the present amendment of the independent claim 77, upon which this claim depends, and the above discussion. The Cooper et al., Blaschke, Baker, Shiao and Brundage et al. patents, alone or in combination, fail to render obvious applicants' invention as set forth in claim 83.

In the February 5, 2009 Advisory Action, the Examiner mentioned the Nadel patent as disclosing an LED and battery both entirely disposed within a single inner recess of housing. The Nadel patent discloses a make-up applicator which has nothing to do with fishing gear. However, to respond to the Examiner's comment, it should be noted that the Nadel make-up applicator has a light in a middle of a handle to shine *into the handle*, which is the reverse of what is in applicants' structure. This clearly teaches away from applicants' claimed invention in which the illuminator is in the distal end of the handle to face and illuminate open area of a net loop. Nor would Nadel allow for submerged operation. Even if Examiner were to apply this reference against applicants' claims, the Nadel make-up applicator would require major reconstruction to arrive at applicants' claimed invention.

In the Advisory Action, the Examiner also stated that the Coleman et al. and Shiao patents “disclose telescoping handles with light and batteries disposed at the forward end of the handle.” These disclosures are from technical fields unrelated to fishing gear. Furthermore, neither of these references has a *submersible* light, and both of them also lack the single inner recess with the LEDs and batteries both *entirely disposed* therein. In fact, the intended functioning of the devices of the Shiao and Coleman et al. references requires their specific constructions, which are different from the applicants’ claimed structure. More specifically, the requirement of at least two separate recesses is critical for the intended and proper functioning of the Shiao and Coleman et al. devices, which clearly teach away from the applicant’s structure. Indeed, any modification of these devices would require major reconstruction and change in the principle of operation of these devices.

The Shiao and Coleman et al. references clearly fall short in disclosing limitations that are lacking from other cited prior art references. Applicants respectively submit that their claims are patentably distinguishable over these references, either alone or in combination with any of the other references.

Applicant respectfully notes that the Supreme Court, in *KSR* (*see KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385), warned that in an obviousness analysis “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” (S.Ct. p 1742; USPQ2d p 1397) Here, the rejections in the last Office Action and any rejections which would use additional references mentioned in the Advisory Action use (or would be using) both improper hindsight and the teaching of applicant’s patent application itself. Such rejections would involve collecting a multiplicity of references from various technological fields to assert that it would have been obvious to one skilled in the art to modify each of the cited references to achieve applicants’ invention. The Federal Circuit has stated: “When prior art references require selective combination ... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself... .” *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d

1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Given the teachings away described above, there can be no motivation for the Examiner's combination; in fact, such rejections would involve hindsight.

Furthermore, MPEP 2143.01, paragraph VI, titled "The Proposed Modification Cannot Change the Principle of Operation of a Reference," provides that:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) ... The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.

The above discussion points out how operations of each of the devices of the various cited references would be dramatically affected by the modifications proposed by the Examiner.

Applicant also respectfully notes that MPEP 2143.02, paragraph VI, titled "Prior Art Must Be Considered in Its Entirety, Including Disclosures That Teach Away from the Claims," provides that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)."

To further support applicants' position, enclosed is a Declaration under 37 CFR 1.132 which lays out facts supporting the patentability of the claimed invention over the rejections in the outstanding PTO action. The evidence provided in the Declaration of Richard Williams supports the non-obviousness of the claimed invention. Not only does it show that no product like the applicants' claimed invention ever existed, but it provides facts referring to the problems encountered in making such a product. More specifically, the Williams declaration shows:

- that in the fishing-gear industry there has been a long-felt need for a fish-landing net which is collapsible for compact storage and transportation and which has a light that

provides illumination focused on the center of the net (Williams Declaration, ¶¶12-14 and 18);

- that such need has not been solved prior to applicants' invention (Williams Declaration, ¶¶17 and 21); and
- the failure of prior attempts to provide useful illuminators on fish-landing nets of the type which are collapsible and have telescoping handles (Williams Declaration, ¶¶15, 16, 19 and 20).

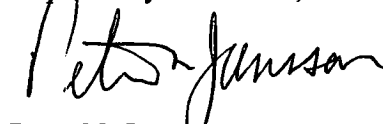
The declaration evidence is specific in showing how prior collapsible fish-landing nets (as in Blaschke) have ruled out the inclusion of illuminators at the net-facing end of the handle (Williams Declaration, ¶¶19 - 21). Expert Williams in his declaration makes the point that, prior to applicants' invention, the ordinary artisan in the field of fish-landing gear "would have thought that a foldable net frame and a net-adjacent illuminator would have been incompatible characteristics (Williams declaration, ¶23).

The Williams declaration characterizes the claimed invention as the one that "might seem like a simple idea, but it is really quite clever and unique and represents an advance and improvement over other products." (Williams declaration, ¶23) In his declaration, expert Williams also states that "[i]t clearly took special creativity by the inventors to make the inventive lighted fish-landing net" and that it "is definitely designed for the avid night angler with a combination of features [expert Williams has] not seen on ordinary landing nets." (Williams declaration, ¶27).

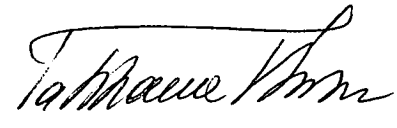
In view of the above, allowance of this application is requested. The Examiner is invited to call the undersigned to resolve any issues that might remain.

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Respectfully submitted,



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